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EXAMINER

GLASS, RUSSELL S

ART UNIT	PAPER NUMBER
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3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/052,659

Applicant(s)

DVORAK ET AL.

Examiner

Russell S. Glass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular the recently amended claim contains the language "wherein at least a subset" that renders the limitation indefinite because it is unclear to one of ordinary skill in the art which identification numbers are required to be application distinct and which are not.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morange et al., (U.S. Pub. 2005/0102374) in view of Felsher, (U.S. Pub. 2002/0010679).

3. As per claim 1, Morange discloses a system for distributed computing in which multiple different applications are in use connected on a common computer network, (Morange, Abstract; Fig. 19A-C; ¶ 50, 255-326) (disclosing a comprehensive Universal Software Platform).

Felsher fails to explicitly disclose such a platform, however, it is likely that such a distributed computing platform is inherent in the system disclosed by Felsher due to the disclosure of multiple different applications within the system, (Felsher, ¶ 10, 91, 94, 120-188, 249). Felsher further discloses comprising a clinical exchange server on the network, the clinical exchange server including memory, (Felsher, Fig. 1, and 2), the clinical exchange server programmed:

- (i) to maintain a reference table, the reference table including a list of applications on the network and the patient identification number used by each application, (Felsher, ¶ 222, 230, 266), wherein at least a subset of the identification numbers used by the applications are application distinct numbers for the patient, (Felsher, ¶ 248, 252, 279) (disclosing a private key in conjunction with an applet wrapper, said private key being a form of application distinct identification number, and said applet is an application to the extent claimed) .
- (ii) to maintain a list of events reported to it by other applications on the network, (Felsher, ¶ 266-268, 279) and
- (iii) to respond to inquiries from a first application about an event recorded by a second application by transmitting a query to the second application based on the information in the reference table and the list of reported events, (Felsher ¶ 264).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine Morange and Felsher. The motivation would have been to provide an infrastructure for efficient transmission, use and security protection of electronic medical records, Felsher, Abstract, ¶ 14).

4. As per claim 2, Felsher discloses a system wherein the clinical exchange server also maintains an abstract about the events sent to it to facilitate exchange of information between the applications, (Felsher, ¶ 266-268, 279) (transactions are events, and an index of transaction records is considered to be an abstract of such events).

5. As per claim 3, Felsher discloses a system wherein the reference table includes a master patient index identification code assigned to the patient as well as an application specific identification number assigned to the patient by each application, (Felsher, ¶ 255, 274, 279) (disclosing both indexed codes and an application-specific rolling code changed after each access, said rolling code being generated by a number generator and considered to be an identification number).

6. As per claim 4, Felsher discloses a system wherein the clinical exchange server also stores health insurance information about each patient so that such health insurance information can easily be accessed by any of the applications, (Felsher, ¶ 318) (the system is HIPAA compatible, thus it is obvious that the system handles health

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insurance information, such as claim information).

7. As per claim 5, Felsher discloses a computer network for operation by a healthcare delivery enterprise, the network including a plurality of servers, the network comprising a clinical exchange server including a storage device, (Felsher, Fig. 1, ¶ 328) (disclosing (6) an entrusted medical information database), the clinical exchange server programmed to store in the storage device a reference table, the reference including a master patient identifier for each patient, and any separate identifying code used for the patient by any of the application programs, wherein at least a subset of the identifying codes are application specific identifying codes for the patient, so that the identifying code used by an application for a patient can be found by accessing the reference table, (Felsher, ¶ 222, 230, 248, 252, 266-268, 279, 334-339) (the patient medical information trust index is a form of reference table that stores a patient I.D used by the encryption application and other recipient applications and applets).

the clinical exchange server further programmed to facilitate information exchange between the applications by using the reference table to extract information from an application requested by another application, (Felsher, ¶ 132, 164-167, 266-272, 279, 334-339) (disclosing query applications that can be used with the reference table).

Felsher fails to expressly disclose operating a plurality of application programs and a list of application programs. However, it is likely that such a plurality of application

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programs and a list of application programs is inherent in the system disclosed by Felsher due to the disclosure of multiple different applications within the system, (Felsher ¶¶ 10, 91, 94, 120-188, 249).

Furthermore, Morange discloses a system operating a plurality of application programs and a list of application programs, (Morange, Abstract; Fig. 19A-C; ¶¶ 50, 255-326) (disclosing a comprehensive Universal Software Platform).

The statement of obviousness and motivation to combine is as disclosed in the rejection of claim 1 and incorporated herein by reference.

8. As per claim 6, Felsher discloses a computer network wherein the clinical exchange server also maintains a table of events associated with patients, the table of events including identifying information about the events and the identification of the application holding information about the event, (Felsher, 266-272) (transaction records are considered to be a table of events).

The statement of obviousness and motivation to combine is as disclosed in the rejection of claim 1 and incorporated herein by reference.

9. As per claim 7, Felsher discloses a computer network wherein the event table also includes an abstract about each of the events, (Felsher, 266-272) (A descriptive header is considered to be a form of abstract).

The statement of obviousness and motivation to combine is as disclosed in the rejection of claim 1 and incorporated herein by reference.

10. Claim 8 contains the same or substantially similar limitations as claim 4 and therefore the reasons for the rejection of claim 4 are incorporated herein by reference.

Response to Arguments

Applicant's arguments filed June 2, 2006 have been fully considered but they are not persuasive for the following reasons:

Applicant generally argues that the combination of Morange and Felsher fails to disclose maintaining a reference table, the reference table including a list of applications on the network and the patient identification number used by each application, wherein at least a subset of the identification numbers used by the applications are application distinct numbers for the patient. However, such a reference table is suggested by Felsher, (Felsher, ¶ 222, 230, 248, 252, 266, 279). Felsher discloses a private key in conjunction with an applet wrapper, said private key being a form of application distinct identification number, and said applet is a form of application or program. The applet is considered to be recipient distinct because it is configured, via a user-specific private key, to decrypt a specific patient medical record. Furthermore, in view of Felsher, it would be obvious to one of ordinary skill in the art to have a separate identification number for each application used to access each individual medical record, such multiple identification numbers being a mere duplication of parts that has no patentable

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significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It is noted in response to applicant's argument that the references fail to teach "application distinct patient application numbers", it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Instead, claim 1 recites "application distinct numbers **for the patient**" (emphasis added). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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RSG
5/16/2007

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